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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,538	03/30/2004	Daisaku Haoto	CU-3660	5324
26530 7590 12/18/2008 LADAS & PARRY LLP 224 SOUTH MICHIGAN AVENUE SUITE 1600 CHICAGO, IL 60604			EXAMINER SPEER, TIMOTHY M	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 12/18/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/813,538

**Applicant(s)**

HAOTO ET AL.

**Examiner**

Timothy M. Speer

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) 4-9, 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10, 13-16, and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto (US 2002/0093285) in view of Olson (USPN 6,541,591).
3. Sugimoto teaches EL devices comprising a silicon oxynitride film formed on a resin substrate. Sugimoto teaches various ratios for the components of the oxynitride film, but fails explicitly to teach the ranges recited in instant claim 1. However, where, as here, the prior art teaches the general conditions of a claimed invention, it is not inventive to discover optimum or workable ranges through routine experimentation. In the present case, applicant has merely altered the proportions of the film components in a routine manner and, accordingly, such endeavor is considered to be prima facie obvious in view of Sugimoto.
4. Additionally, Sugimoto fails to teach that the substrate or the top surface of the film layered body on which the protective coat is coated is selected from the group consisting of acrylic UV curable resins, polyethylene naphthalate and polyethersulfone, as recited in the newly amended claims. Sugimoto teaches that the substrates may be formed resins, such as polycarbonate (see paragraph [0031]). Olson teaches that polyethylene naphthalate is a functional equivalent of polycarbonate as a base layer in optical products (see col. 3, lines 9-31, for instance). Therefore, it would have been obvious to one having ordinary skill in the art to

employ polyethylene naphthalate as the substrate of Sugimoto, since Olson teaches that polyethylene naphthalate is a functional of the polycarbonate substrate explicitly disclosed by Sugimoto.

5. Regarding claims 19-21, as discussed above, Sugimoto in view of Olson renders obvious the claimed ratio of the film constituents as well as the substrate materials. With respect to the process limitations recited therein, these limitations are not considered to distinguish over the applied prior art, since applicant has failed to demonstrate that the recited process step produces a product which is materially different than the applied prior art. Applicant is claiming a product and not a process.

**6. Claims 1-3, 10, 13-16 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tazawa (US 2002/0043929) in view of Olson (USPN 6,541,591).**

7. Tazawa teaches EL devices comprising first and second layers formed on a resin substrate (abstract). The layers may be formed of such materials as silicon oxide, silicon nitride and silicon oxynitride (see paragraph [0057]-[0059]). Moreover, Tazawa teaches that the materials of one layer, e.g., SiO<sub>2</sub>, is a functional equivalent of components of other layers, e.g., alumina (id.). Therefore, it would have been obvious to employ the presently claimed materials in the structure of Tazawa, since Tazawa suggests the use of such materials. Moreover, to modify the relative amounts of a component in the films, e.g., Si, O, and N, would have been obvious to one having ordinary skill in the art since, where the prior art teaches the general conditions of a claim, it is not inventive to discover optimum or workable ranges through routine experimentation. Therefore, it is the Examiner's position that the present claims are prima facie obvious in view of Tazawa.

8. Additionally, Tazawa fails to teach that the substrate or the top surface of the film layered body on which the protective coat is coated is selected from the group consisting of acrylic UV curable resins, polyethylene naphthalate and polyethersulfone, as recited in the newly amended claims. Tazawa teaches that the substrates may be formed resins, such as polycarbonate (see paragraph [0075]). Olson teaches that polyethylene naphthalate is a functional equivalent of polycarbonate as a base layer in optical products (see col. 3, lines 9-31, for instance). Therefore, it would have been obvious to one having ordinary skill in the art to employ polyethylene naphthalate as the substrate of Tazawa, since Olson teaches that polyethylene naphthalate is a functional of the polycarbonate substrate explicitly disclosed by Tazawa.

9. Regarding claims 19-21, as discussed above, Tazawa in view of Olson renders obvious the claimed ratio of the film constituents as well as the substrate materials. With respect to the process limitations recited therein, these limitations are not considered to distinguish over the applied prior art, since applicant has failed to demonstrate that the recited process step produces a product which is materially different than the applied prior art. Applicant is claiming a product and not a process.

#### ***Response to Arguments***

10. Applicant's arguments filed 09/17/08 have been fully considered but they are not persuasive. With respect to Sugimoto, applicant first argues that Sugimoto is made by a different process than the present invention, using oxygen as a gas for a SiN target. This is not persuasive, while a different process may be used, there is no evidence of record demonstrating that any alleged differences in process conditions produce a product materially different than presently claimed. Applicant is claiming a product and not a process.

11. Additionally, applicant asserts that Sugimoto is not enabled with respect to the ratios of Si, N, and O in the present claims. To this end, applicant relies on comparative examples 1 and 2 present in the originally filed specification as demonstrating Sugimoto is not enabled. Regarding these comparative examples, they appear not to be a comparison with Sugimoto and, accordingly, are not persuasive. The specification discloses that comparative examples 1 and 2 were carried out under conditions "close to" those of Sugimoto (see specification at pages 31 and 32).

12. Moreover, at page 10 of the response, applicant asserts that Sugimoto is not enabled, relying merely on attorney argument. It is well settled that "[t]he arguments of counsel cannot take the place of evidence in the record." *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) (MPEP 2145). Moreover, assertions of inoperability of the prior art must be supported affidavit or declaration (see MPEP 713.01(c)). Applicant has failed to adduce such evidence and, accordingly, the arguments with respect to Sugimoto are not persuasive.

13. With respect to Tazawa, applicant asserts that Tazawa is not enabled, relying on attorney argument. It is well settled that "[t]he arguments of counsel cannot take the place of evidence in the record." *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) (MPEP 2145). Moreover, assertions of inoperability of the prior art must be supported affidavit or declaration (see MPEP 713.01(c)). Applicant has failed to adduce such evidence and, accordingly, the arguments with respect to Tazawa are not persuasive.

14. Additionally, applicant asserts that Tazawa fails to teach the claimed combination of a silica and silicon nitride layer. This is not persuasive, as pointed out in the rejection, Tazawa teaches that the materials disclosed therein are fungible and to replace one with the other is considered to be prima facie obvious.

15. Finally, applicant argues that Tazawa fails to teach the presently claimed thickness. For reasons of record herein, as well as the final rejection dated 06/11/07, it is the Examiner's position that it would have been obvious to optimize the thickness of the layers disclosed in Tazawa, since Tazawa is not limiting with respect to thickness. Such endeavor is considered to be within the level of ordinary skill in the art.

16. In light of the above, applicant's arguments have been considered, but are not found to be persuasive.

### ***Conclusion***

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Speer whose telephone number is (571)272-8385. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy M. Speer/  
Primary Examiner  
Art Unit 1794